UNITED STATES PATENT AND TRADEMARK OFFICE



Webinar for Patent Pro Se, Pro Bono, and Law School Clinic Certification Programs







Program Agenda

Time	Topic		
2:00 - 2:10	Opening Remarks		
2:10 - 3:00	Patent Pro Bono Panel Discussion		
3:00 - 3:10	Break		
3:10 - 4:00	Law School Clinic Certification Program		
4:00 - 4:10	Break		
4:10 - 5:00	Pro Se Assistance Program		



Opening Remarks

Andrew Byrnes—Chief of Staff, USPTO



Patent Pro Bono Program – Free Legal Representation

Speakers and Panel Discussion

May 21, 2015

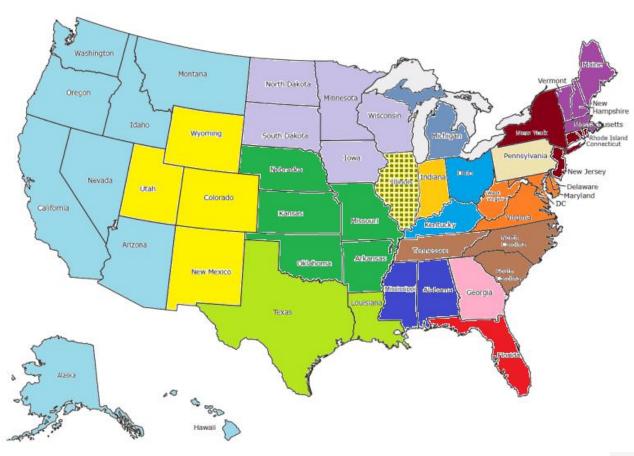


Pro Bono Guest Speaker

 Jenny McDowell – USPTO's Patent Pro Bono Program Coordinator



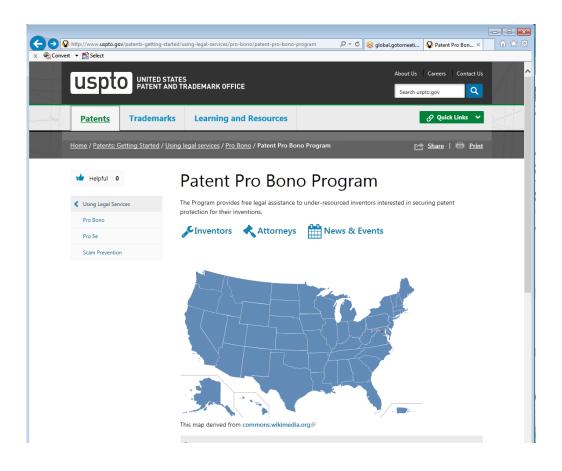
Patent Pro Bono Coverage





Patent Pro Bono Information

- Website: www.uspto.gov/probonopatents
- E-mail: <u>PatentProBono@uspto.gov</u>





Pro Bono Guest Speaker

 Miriam DeChant – Administrator for Pennsylvania's Regional Patent Pro Bono Program



Pro Bono Guest Speaker

 James H. Patterson – Founding Partner of Patterson Thuente IP and Volunteer Attorney



Inventor Interview



Q&A with Pro Bono Guest Panel

Jenny McDowell

USPTO's Patent Pro Bono Program Coordinator

Miriam DeChant

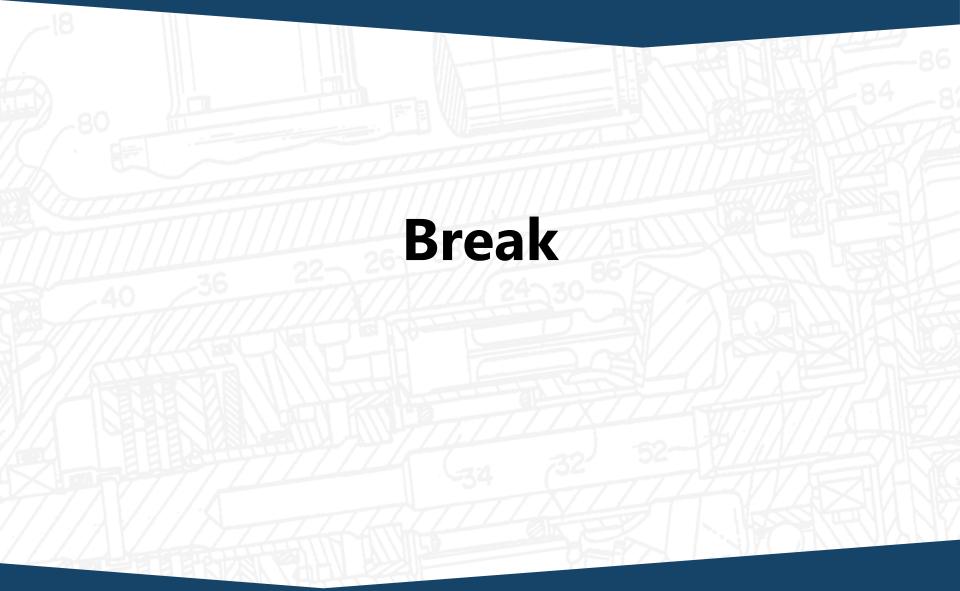
Administrator for Pennsylvania's Regional Patent Pro Bono Program

James H. Patterson

Founding Partner of Patterson Thuente IP and Volunteer Attorney

Thank You







Law School Clinic Certification Program – Free Legal Assistance

Jennifer A. Harchick Attorney, Office of Enrollment and Discipline

May 21, 2015



Introduction

Presentation on the Program

Discussion with Clinic Directors

Questions and Answers



What Is the Program?

- The Law School Clinic Certification Program ("Program"):
 - permits law school students enrolled in a participating law school's clinic to practice patent and/or trademark law before the USPTO
 - under the guidance and supervision of a Faculty Clinic Supervisor
 - while providing their legal services pro bono (free) to Inventors/Applicants.
- Inventors/Applicants are responsible for USPTO filing fees and costs



History of the Program

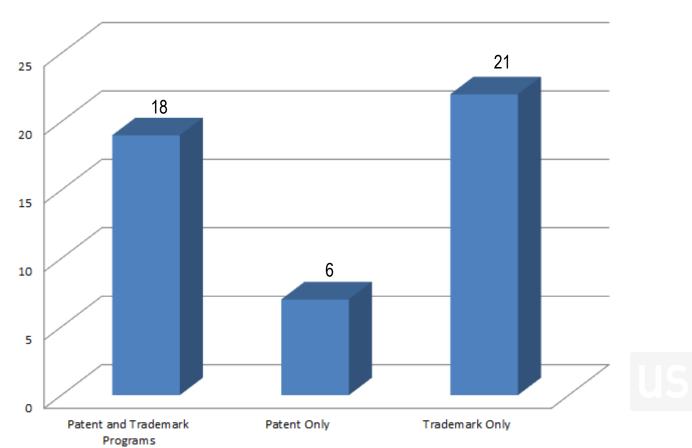
- The Program began in the Fall Semester of 2008 and has been expanded a number of times
- On December 16, 2014, President Obama signed into law Public Law 113-227, which removed the "pilot" status of the Program and established the Program until 2024



Scope of Coverage Law School Clinic Program

 Currently, 45 law schools are in the Program from all across the United States

Law School Clinic - Scope of Coverage



LAW SCHOOL CLINIC CERTIFICATION PROGRAM



States with a Clinic in the Program

25 States, District of Columbia, and Puerto Rico

- Arizona
- California
- Colorado
- Connecticut
- District of Columbia
- Idaho
- Illinois
- Indiana
- Maine

- Maryland
- Massachusetts
- Michigan
- Minnesota
- Missouri
- New Hampshire
- New Jersey
- New York
- North Carolina

- Ohio
- Oregon
- Puerto Rico
- Rhode Island
- Tennessee
- Texas
- Virginia
- Washington
- West Virginia



Program Administration

- The Program is administered by the Office of Enrollment and Discipline
- The Director of the Office of Enrollment and Discipline grants the participating law students limited recognition to represent Inventors/Applicants before the USPTO while enrolled in a participating law school clinic and under the supervision of an approved Faculty Clinic Supervisor



Faculty Clinic Supervisor

- Each clinic must have at least one approved Faculty Clinic Supervisor
- Each Faculty Clinic Supervisor:
 - is an experienced practitioner who supervises the participating law school clinic students
 - o is responsible for all applications filed by the clinic
 - reviews and approves all documents filed with the USPTO by the clinic
 - is approved by the Office of Enrollment and Discipline

Faculty Clinic Supervisor

- For patents must, at a minimum, be a registered patent attorney or patent agent and have at least 3 years experience prosecuting patent applications before the USPTO within the last 5 years
- <u>For trademarks</u> must, at a minimum, be a licensed attorney and have at least 3 years experience prosecuting trademark applications before the USPTO within the last 5 years

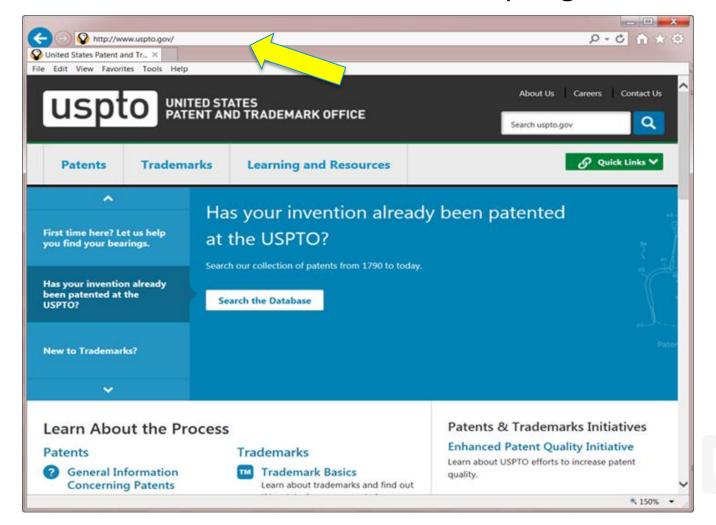


Law Students

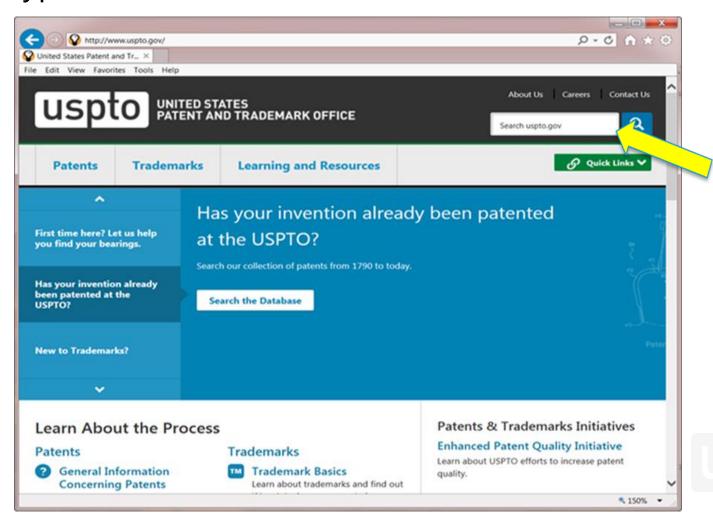
- Draft and file patent applications and/or trademark applications for Inventors/Applicants who are clients of the law school clinic
- Draft and file responses to Office Actions and other documents in applications
- Communicate with patent examiners and/or trademark examining attorneys for the applications of clinic clients
- Communicate with and counsel clinic clients regarding their patent and trademark applications



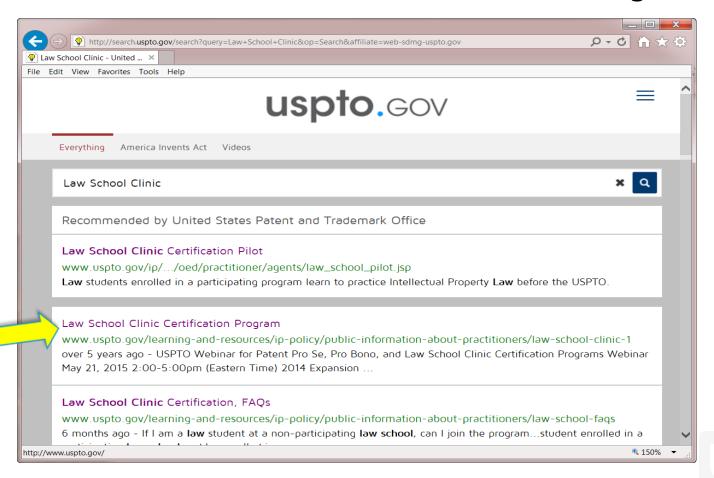
Go to the USPTO website: www.uspto.gov



Type in the Search Box: "Law School Clinic"



Click on "Law School Clinic Certification Program"



http://www.uspto.gov/learning-and-resources/ip-policy/public-information-about-practitioners/law-school-clinic-1





Service Inquiries

 Please contact the participating law schools at the e-mail address listed on the USPTO website if you wish to make general inquiries or request legal services



Participating Law Schools

Participating Law Schools	E-mail Address	IP Practice Area	Geographic Area** (from which the law school may accept clients)
American University, Washington College of Law	ipclinic@wcl.american.edu	Trademarks	District of Columbia, Maryland and Virginia Only
Arizona State University College of Law	<u>patent_clinic@asu.edu</u> (patents) <u>Trademark_clinic@asu.edu</u> (trademarks)	Patents and Trademarks	All United States
Brooklyn Law School	BLIP@brooklaw.edu	Patents	All United States
California Western School of Law	TrademarkClinic@cwsl.edu	Trademarks	All United States
Case Western Reserve University School of Law	lawclinic@case.edu	Patents	Northern Ohio Only
Fordham University School of Law	IPILClinic@lsls.fordham.edu	Patents and Trademarks	Northeastern United States Only
Howard University School of Law	tmclinic@law.howard.edu	Trademarks	District of Columbia, Maryland and Virginia Only

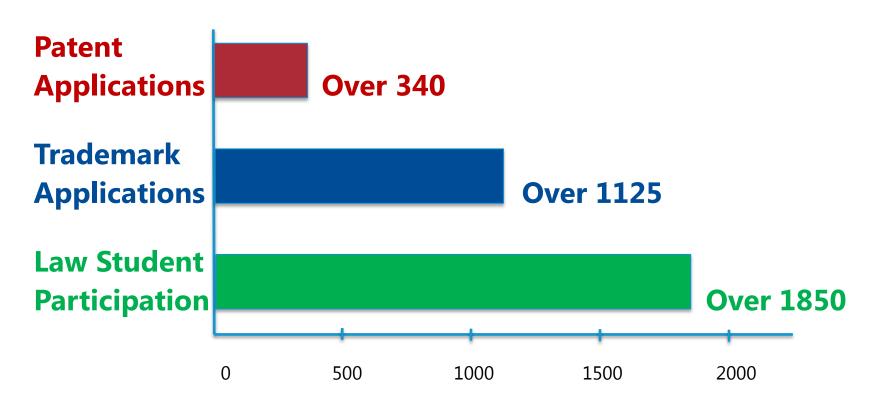
^{**}ACCEPTANCE AS A CLIENT IS SUBJECT TO THE LAW SCHOOL'S REQUIREMENTS AND DISCRETION

For a complete list of the participating law school, please see Appendix.

Eligibility for Pro Bono Services

- Each law school determines the types of requirements that a person or company must meet in order to qualify to receive pro bono legal services from its clinic
- Examples of types of requirements:
 - Income threshold of the person/company
 - Geographic location of the person/company
 - Subject matter and/or complexity of the requested service(s)
 - Availability of clinic to take on new clients

Program Activity To Date





Transferring Applications

 Patent and trademark applications may be transferred into the Program after the application has already been filed



Benefits of the Program - Trademarks

- Shortened pendency of trademark applications from filing date to date of first Office Action
 - Average pendency to first Office Action is 1-2 months for applications filed through the Program
 - Average pendency to first Office Action is about
 3 months for general trademark applications
- Examined by dedicated Trademark Examining Attorneys



Benefits of the Program - Patents

 2 avenues for patent prosecution in the Program

Regular prosecution

 Request to Make Special (in limited applications)



Benefits of the Program - Patents

 Where a Request to Make Special is filed, shortened pendency to first Office Action

- From the date that a Request to Make Special is granted, average pendency to a first Office Action is about 4 to 6 months
- Without Request to Make Special, average pendency to a first Office Action is about 18+ months



Request to Make Special - Patents

- Each participating law school clinic may designate a predetermined number of patent applications per academic year for advancement of examination
- Each application must meet all of the requirements in order to be accorded special status under a Request to Make Special
- Filing a Request to Make Special in a patent application is subject to the discretion of the clinic's Faculty Clinic Supervisor



Requirements for a Request to Make Special

- Non-provisional utility application
- Application contains 3 or fewer independent claims and 20 or fewer total claims; no multiple dependent claims
- Claims directed to a single invention
- Filed on behalf of a small or micro entity



Requirements for a Request to Make Special (cont.)

 Pre-examination search conducted, and the results of the search disclosed to the USPTO

 Request filed at least one day prior to date a first Office Action appears in the Patent Application Information Retrieval (PAIR) system

Accompanied by a request for early publication



Questions about Law School Clinic Program?

• **Phone:** 571-272-4097

• E-mail: lawschoolpilotinformation@uspto.gov

- Jennifer A. Harchick, Attorney, Office of Enrollment and Discipline
 - o <u>Jennifer.Harchick@uspto.gov</u>



Q&A With Clinic Directors Guest Panel

Victoria Phillips

American University, Washington College of Law Clinic Director and Trademark Faculty Clinic Supervisor

Megan Carpenter

Texas A&M University School of Law Clinic Director

Patricia Campbell

University of Maryland School of Law Clinic Director and Trademark Faculty Clinic Supervisor

Thank You



Break



Pro Se Assistance Program – Free Help Without Legal Representation

Michael Razavi Office of Innovation Development

Darnell Jayne
Supervisory Patent Examiner



Purpose of Pro Se Assistance Program

- Provide increased assistance to the independent inventor community
- To educate pro se applicants
- To increase the quality of incoming pro se applications as well as responses to outstanding correspondence from the Office



Why Have a Program?

 The 2011 America Invents Act directs the USPTO to provide affirmative assistance to the independent inventors and small business

 A White House Executive Action resulted in the creation of the pro se assistance program

Pro Se Assistance Program

Pro se Assistance Program

Consolidation of existing education, outreach and pre filing assistance for independent inventors into the Office of Innovation Development

Team of individuals trained to serve independent inventors and pro se applicants and to act as a liaison with other business units serving pro se applicants

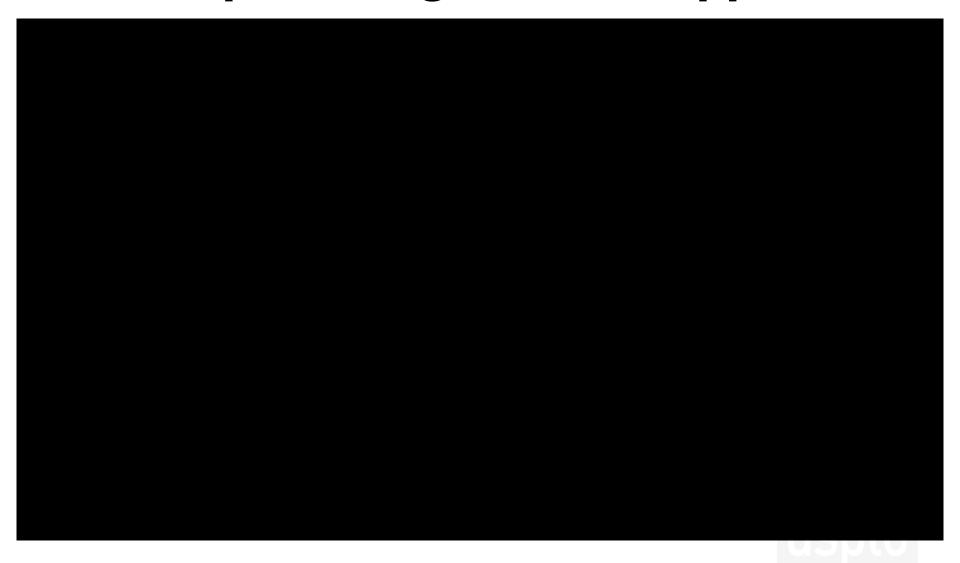
Eligibility for Pro Se Assistance Program

No income threshold

 Knowledge of the patent system is helpful but not required

 Possession of an invention that you invented (not just an idea)

Roadmap to Filing a Patent Application



Function of Pro se Assistance Program

Education

Outreach

Resources

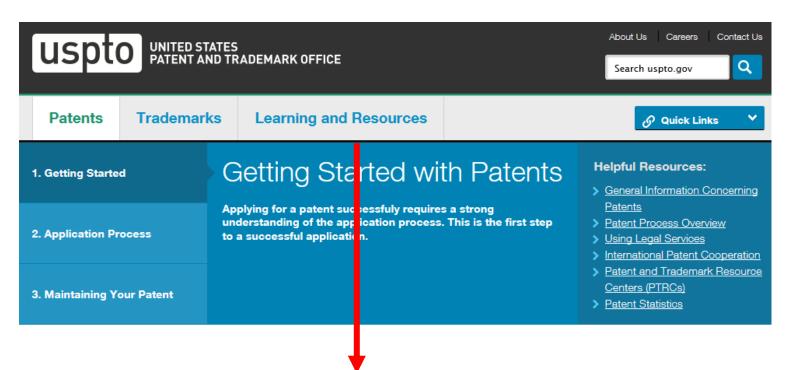
Education

- Procedural assistance for filing provisional and non-provisional applications
 - General information including the different types of applications
 - Assistance with finding and deciphering forms
 - Signature requirements
- Targeted support to connect applicants with relevant resources and information
 - Checklists
 - Claim drafting presentations
 - Examples of how to arrange your specification
 - How to perform a search of the invention
- Walk-in assistance
 - Dedicated personnel for assisting pro se applicants wishing to file on EFS including formalities review
 - Access to fully equipped public search facilities in public search room

Outreach

- Conferences and workshops
- Inventors Eye Newsletter
 - Bimonthly publication for the independent inventor community (http://www.uspto.gov/learning-and-resources/inventors-eye-newsletter)
- 1-on-1 meetings
- Enhanced customer service

Resources: USPTO Website www.USPTO.gov



- Look to contents of
 - "Learning and Resources" pull-down tab
 - Find "Inventors & Entrepreneurs" and select



Resources: Inventors & Entrepreneurs Page

Inventors & Entrepreneurs Resources



Patents for Inventors

The patent process can be challenging if you are not familiar with it. Below are links with useful information regarding the patent process.

- > Patents
- > Patent Help
- > Patent Process Overview
- > Search for Patents
- > Inventors Assistance Center
- > Official Gazette for Patents

Trademarks for Inventors & Entrepreneurs

The trademark process can be confusing for a beginner, so the links below provide useful information on registering a trademark with the USPTO.

- > Trademark Basics
- Trademark Electronic Search System (TESS)
- Trademark Electronic Application System (TEAS)
- Trademark Status and Document Retrieval (TSDR)
- Electronic Trademark
 Assignment System (ETAS)
- Assignments on the Web (AOTW)
- Trademark Trial and Appeal Board (TTAB)
- Trademark Manual of Examining Procedure (TMEP)

Pro Se - Pro Bono

business who has limited

bono ("for free") attorney

> Inventors Eye | Pushing

> Patent and Trademark

Resource Centers

> Law School Clinics

with Pro Bono Assistance

> Interest For

> Pro Bono

representation through the

Nationwide Pro Bono Program.

Are you an inventor or small

resources and needs help applying

for a patent on an invention? If so,

you may be eligible to receive pro



Inventors & Entrepreneurs Assistance

The Inventors Assistance Center (IAC) provides patent information and services to the public. The IAC is staffed by former supervisory patent examiners and experienced primary examiners who answer general questions concerning patent examining policy and procedure. The Trademark Assistance Center can answer general questions about the trademark process or provide guidance on the type of information to include on a form, but may not provide specific legal advice.

- > Inventors Assistance Center
- > Patents Ombudsman Program
- > BusinessUSA®
- > Trademark Assistance Center



Education & Information

Guides and additional resources and information for inventors.

- > Scam Prevention
- Provisional Application for Patent
- General Information Concerning Patents
- A Guide to Filing a Nonprovisional Utility Patent Application
- A Guide to Filing A Design Patent Application
- > Basic Facts About Trademarks
- > Financial Manager



Scam Prevention

While the USPTO does not investigate complaints or participate in any legal proceedings against invention promoters/promotion firms under the American Inventors Protection Act of 1999, the USPTO with provide a public forum for the publication of complaints concerning invention promoters/promotion firms.

- Scam Prevention Basic
- ➤ Non-USPTO Trademark Solicitations @
- American Inventors Protection Act of 1999
- > Consumer Protection ₪



Current Events

Information about conferences and conventions.

> Upcoming Events

Inventors Eye | Events & Announcements



State Resources

> United States Map

uspto

Resources: Pro Se Assistance Program

Pro Se Assistance Program

The Pro Se Assistance Program is the United States Patent and Trademark Office's comprehensive pilot to expand outreach to inventors who file patent applications without the assistance of a registered patent attorney or agent (also known as "pro se" filing). On this page, you will find information about the program and how it works, and guides and resources for some of the most common issues that pro se applicants encounter.

If you've got a great idea for an invention but you're not sure what a patent is or why you might need one, watch the animated video below.



- · Getting Started with Pro Se Assistance
- Application Checklist
- · Nonprovisional Utility Patent Application Checklist
- · Understanding EFS-Web
- In-Person Assistance (by Appointment)
- · Contact the Pro Se Assistance Program



Resources: Application Checklist

Application Checklist

A patent application is a collection of documents that conform to U.S. laws, rules, and guidelines outlined in the Manual of Patent Examining Procedure. The specific list of documents and forms depends on a number of factors, including the type of patent application, the protection sought, and the invention itself. The Pro Se Assistance Program makes this checklist of documents and forms available for your use in preparing your application. While not comprehensive, it contains the most commonly required elements to form a nonprovisional utility patent application.

Nonprovisional Utility Patent Application Checklist



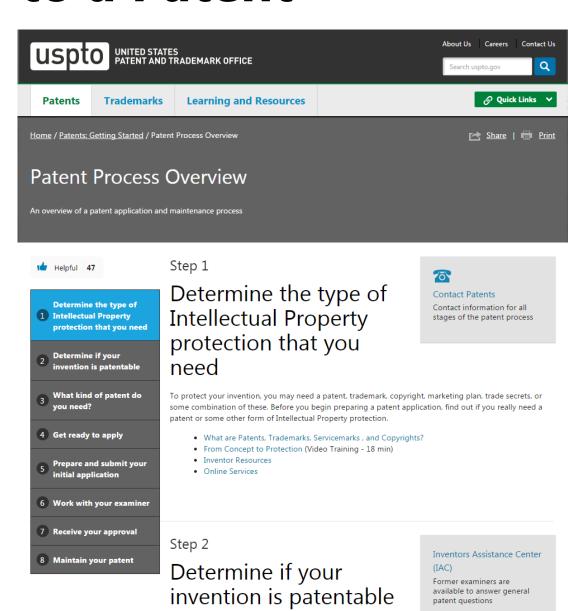


Process to a Patent

Patent Law is complex

 Not all patent applications will qualify for a patent

 Applicants must make many decisions along the way

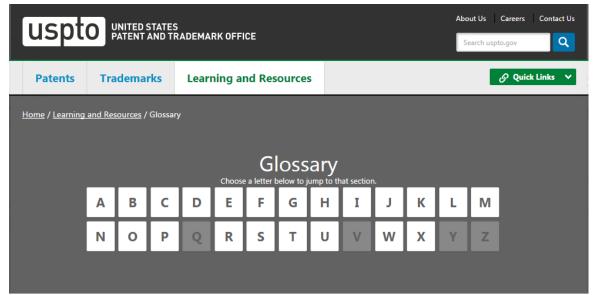


Why Educating Yourself is Important

- Innovation fuels economic growth
- Intellectual property protection is critical to foster innovation but it costs money and takes time
- Like any investment, you want to find out whether you can protect your invention
- Understanding the framework of the patent filing and examination process helps you to understand any next steps

Why Educating Yourself is Important

The Office uses a lot of legal and technical jargon



A-Z definitions of intellectual property terminology



AAU

amendment to allege use

ABA#

American Bankers Association number - often referred to as the "transit routing number", is the nine (9) digit electronic address of a financial institution. The ABA number is encoded in the MICR (Magnetic Ink Character Recognition) line of all checks, and is assigned to each financial institution and each branch office of that financial institution.

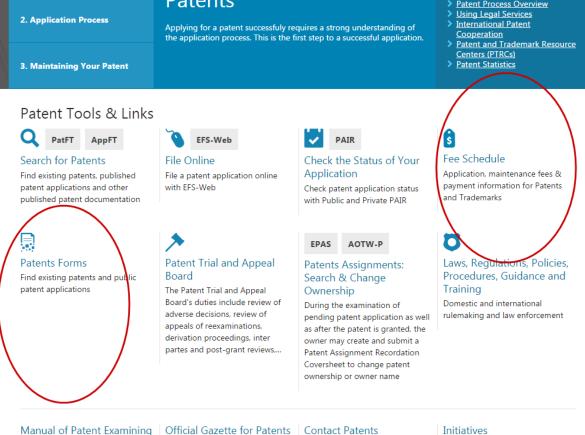
abandonment (patents)

A patent application becomes abandoned for failure to file a complete and proper reply as the condition of the application may require within the time period provided under 37 CFR § 1.134 and § 1.136 unless an Office action indicates otherwise.

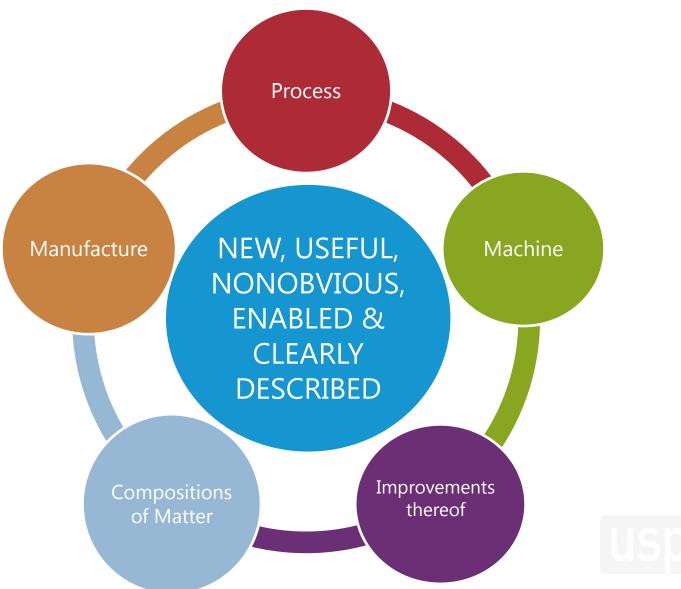
Why Educating Yourself is Important



Forms, Format, Formalities, and Fees

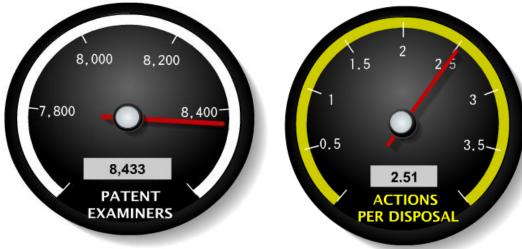


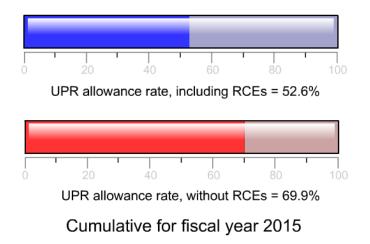
What is Patentable?



How Long Is the Wait?







April 2015

Cumulative for fiscal year 2015

How Much Will Filing Cost?

- Regular or Undiscounted
- Small Entity
 - small business or individual
 - 50% discount on fees
- Micro Entity
 - small entity
 - no more than four previously filed applications
 - Limit on income is equal to three times the median household income for the preceding calendar year
 - parties with an ownership interest must qualify as a micro entity
 - 75% discount on most fees

Scope of Pro Se Assistance

- Legal Assistance NO
 - Different from Pro Bono Program and Law School Clinic Certification Program

- Customer Service YES
 - Procedural Assistance
 - Work directly with the inventor to assure that the inventor is directed to the appropriate customer service center

Legal Assistance

- Staff may not offer legal assistance (and advice) to independent inventors and pro se applicants
- Staff may suggest employing an attorney or agent (MPEP 401, 37 CFR 1.31)
- Staff does not look at the merits of the invention, its marketability or its patentability
- Staff is limited to discussing statutes, rules, procedure and other education based questions that independent inventors may have

Customer Service

 One-on-one interaction between applicant and USPTO personnel

 Procedural assistance on forms, format, and formalities

Support tailored to applicant's application



SMILE

MAINTAIN customer service
INFORM applicant of options
LISTEN to applicant
EDUCATE applicant



Audience Questions?



Pro Se Assistance

Email: <u>IndependentInventor@uspto.gov</u>

Toll free phone number: 1-866-767-3848

Thank You



Appendix



Participating Law Clinic Certification Programs

Participating Law Schools	E-mail Address	IP Practice Area	Geographic Area** (from which the law school may accept clients)
American University, Washington College of Law	ipclinic@wcl.american.edu	Trademarks	District of Columbia, Maryland and Virginia Only
Arizona State University College of Law	<u>patent clinic@asu.edu</u> (patents) <u>Trademark clinic@asu.edu</u> (trademarks)	Patents and Trademarks	All United States
Brooklyn Law School	BLIP@brooklaw.edu	Patents	All United States
California Western School of Law	TrademarkClinic@cwsl.edu	Trademarks	All United States
Case Western Reserve University School of Law	<u>lawclinic@case.edu</u>	Patents	Northern Ohio Only
Fordham University School of Law	IPILClinic@lsls.fordham.edu	Patents and Trademarks	Northeastern United States Only
Howard University School of Law	tmclinic@law.howard.edu	Trademarks	District of Columbia, Maryland and Virginia Only

^{**}ACCEPTANCE AS A CLIENT IS SUBJECT TO THE LAW SCHOOL'S REQUIREMENTS AND DISCRETION

Participating Law Schools	E-mail Address	IP Practice Area	Geographic Area** (from which the law school may accept clients)
Indiana University Maurer School of Law	ipclinic@indiana.edu	Patents and Trademarks	Indiana Only
Lewis & Clark College School of Law	sblc@lclark.edu	Trademarks	Oregon Only
Lincoln Law School of San Jose	ipclinic@lincolnlawsj.edu	Patents and Trademarks	All United States
Loyola University Chicago School of Law	businesslaw@luc.edu	Trademarks	Chicago, Illinois Area Only
New York Law School	ptoclinic@nyls.edu	Patents	All United States
North Carolina Central University School of Law	ipclinic@nccu.edu	Patents and Trademarks	North Carolina Only
Northwestern University School of Law	elc@law.northwestern.edu	Trademarks	Illinois Only (preference to Chicago, Illinois Area)

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Participating Law School	E-mail Address	IP Practice Area	Geographic Area** (from which the law school may accept clients)
Roger Williams University School of Law	<u>cedc@rwu.edu</u>	Trademarks	Rhode Island and surrounding States Only
Rutgers Law School – Newark	jkettle@kinoy.rutgers.edu	Trademarks	All United States
Saint Louis University School of Law	<u>LegalClinics@slu.edu</u>	Trademarks	Missouri and Illinois Only
South Texas College Of Law	<u>patent@stcl.edu</u> (patents) <u>trademark@stcl.edu</u> (trademarks)	Patents and Trademarks	Texas and Louisiana Only (Patents) All United States (Trademarks)
Southern Methodist University Dedman School of Law	<u>patentclinic@smu.edu</u> (patents) <u>trademarkclinic@smu.edu</u> (trademarks)	Patents and Trademarks	Dallas-Forth Worth, Texas and Northern Texas on a limited basis
Texas A&M University School of Law	<u>patents@law.tamu.edu</u> (patents) <u>trademarks@law.tamu.edu</u> (trademarks)	Patents and Trademarks	All United States
The George Washington University School of Law	sbced_uspto_intake@law.gwu.edu	Trademarks	District of Columbia Only

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Participating Law Schools	E-mail Address	IP Practice Area	Geographic Area** (from which the law school may accept clients)
The John Marshall Law School	<u>patentclinic@jmls.edu</u> (patents) <u>trademarkclinic@jmls.edu</u> (trademarks)	Patents and Trademarks	All United States (preference to Illinois and Midwest States) (Patents) All United States (Trademarks)
Thomas Jefferson School of Law	<u>PatentClinic@tjsl.edu</u> (patents) <u>TrademarkClinic@tjsl.edu</u> (trademark s)	Patents and Trademarks	Southern California and Baja, California (Patents) San Diego County, California (Trademarks)
University of Akron School of Law	trademarkclinic@uakron.edu	Trademarks	All United States
University of California, Los Angeles School of Law	uspto@law.ucla.edu	Patents and Trademarks	All United States (preference to Southern California)
University of Colorado Law School	elawclin@colorado.edu	Patents	Colorado Only
University of Connecticut School of Law	iplawclinic@uconn.edu	Patents and Trademarks	Connecticut Only

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Participating Law School	E-mail Address	IP Practice Area	Geographic Area** (from which the law school may accept clients)
University of Detroit Mercy School of Law	IPClinic@udmercy.edu	Patents	All United States (preference to Michigan and Ohio) and Ontario, Canada
University of Idaho College of Law	trademarks@uidaho.edu	Trademarks	Idaho Only
University of Maryland School of Law	miplrc@law.umaryland.edu	Patents and Trademarks	Maryland and District of Columbia Metro Area Only
University of New Hampshire School of Law	ipclinic@law.unh.edu	Trademarks	All United States
University of North Carolina at Chapel Hill School of Law	whitede@email.unc.edu	Trademarks	All United States
University of Notre Dame Law School	ipclinic@nd.edu	Patents and Trademarks	Midwestern United States Only

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Participating Law School	E-mail Address	IP Practice Area	Geographic Area** (from which the law school may accept clients)
University of Puerto Rico School of Law	ipclinic@ferraiuoli.com	Patents and Trademarks	Puerto Rico Only
University of San Francisco School of Law	<u>lawclinic@usfca.edu</u>	Trademarks	All United States
University of Tennessee College of Law	bkrumm@utk.edu	Trademarks	All United States
University of Washington School of Law	elcinfo@uw.edu	Patents and Trademarks	Washington Only
Vanderbilt Law School	legal.clinic@vanderbilt.edu	Trademarks	All United States
Wayne State University Law School	patentclinic@wayne.edu	Patents	All United States

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Participating Law School	E-mail Address	IP Practice Area	Geographic Area** (from which the law school may accept clients)
West Virginia University School of Law	eilc-admin@wvulaw-eilc.net	Trademarks	All United States
Western New England University School of Law	marie.fletcher@law.wne.edu	Trademarks	Western Massachusetts and Northern Connecticut Only
William Mitchell College of Law	<u>jean.backes@wmitchell.edu</u>	Patents and Trademarks	Upper Midwestern United States Only

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